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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/655,957

09/05/2003

Michael Gauselmann

ATR-A-118

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EXAMINER

HALL, ARTHUR O

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

11/23/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/655,957	<b>Applicant(s)</b> GAUSELMANN, MICHAEL	
	<b>Examiner</b> Arthur O. Hall	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

Examiner acknowledges applicant's amendment of claims 1, 10, 16, 18 and 21 in Response dated 9/27/2007 to Non-final Office Action dated 6/27/2007. Examiner also acknowledges applicant's election of claims 18-21 as part of the election of species under the restriction requirement set forth in this office action, thereby making claims 1-17 drawn to a non-elected species. Therefore, claims 18-21 are pending in the application and subject to examination as part of this office action.

Examiner acknowledges that the nonstatutory grounds of the Obviousness-type Double Patenting rejection were not overcome by the applicant because the applicant has not yet filed a terminal disclaimer in anticipation that the provisionally rejected claims shall be amended away from the claims of the copending Application No. 10/658,566 during prosecution. Therefore, Examiner maintains the provisional rejection of claims 2, 4 or 21 and 17 on the ground of nonstatutory obviousness-type double patenting until such time that claims 2, 4 or 21 and 17 are no longer unpatentable over claims 1, 3 and 23, respectively, of copending Application No. 10/658,566 (US Patent Application Publication 2005/0054414; Gauselmann).

Examiner acknowledges that applicant's arguments in the Response dated 9/27/2007 directed to the rejection of claims 1-17 set forth under 35 U.S.C. 102(e) and 35 U.S.C. 103(a) in the Non-final Office Action dated 6/27/2007 are deemed moot in

light of the election of species encompassing claims 18-21, thereby drawing claims 1-17 to a non-elected species as set forth below.

Examiner acknowledges that applicant's amendments reciting "N different jackpots" in the Response dated 9/27/2007 directed to the rejection set forth under 35 U.S.C. 102(e) and 35 U.S.C. 103(a) in the Non-final Office Action dated 6/27/2007 have caused a scope of enablement problem with regard to the number of jackpots enabled by disclosure of the specification. Therefore, Examiner has set forth below a new rejection of claims 18-21 under 35 U.S.C. § 112, first paragraph for scope of enablement of the term "N different jackpots."

Examiner acknowledges that applicant's arguments directed to the rejection set forth under 35 U.S.C. 102(e) are deemed unpersuasive, in part, in light of the evidence disclosed in the Baerlocher (US Patent 7,029,395; hereinafter Baerlocher '395) and Baerlocher (US Patent 7,001,273; hereinafter Baerlocher '273) references cited in the Non-final Office Action dated 6/27/2007, and, in part, in view of applicant's amendments and applicant's arguments made in the Response dated 9/27/2007 to the Non-final Office Action dated 6/27/2007. Thus, the rejections under 35 U.S.C. 102(e) are not withdrawn. Therefore, Examiner maintains the grounds of rejection under 35 U.S.C. § 102(e) as set forth below.

Examiner acknowledges that applicant's arguments directed to the rejection set forth under 35 U.S.C. 103(a) are deemed moot in light of claims 7, 9 and 13 being drawn to a non-elected species.

***Election/Restrictions***

This application contains claims directed to the following patentably distinct species: Species I and II.

Species	Figures	Claims
I	1-4	1-17
II	2	18-21

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record. Moreover, the species are independent or distinct because Species I is directed to a method including minimum and maximum bets so as to evaluate a jackpot winning outcome based on the sum of the jackpots and Species II is directed to a method including occurrence of a jackpot-incrementing symbol or certain icons so as to evaluate a jackpot winning outcome, wherein each of these species have distinct utility from each other in that each species is capable of performing the task of determining a jackpot winning outcome in a procedural manner using different structural features.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there are no generic claims.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly

and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

During a telephone conversation with Attorney Brian Ogonowsky on 11/16/2007, a provisional election was made without traverse to prosecute the invention of Species II, claims 18-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18-21 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for five different jackpots, does not reasonably provide enablement for N different jackpots. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Examiner finds that a maximum of five jackpots are supported by the disclosure of the specification, not an infinite number of jackpots as now claimed via the amendment reciting the term "N different jackpots."

***Claim Rejections - 35 USC § 102***

Examiner maintains and incorporates herein by reference the grounds of rejection of the claims under 35 U.S.C. § 102(e) as described in the Non-final Office Action dated 6/27/2007 because the scope of the claims as amended in the Response dated 9/27/2007 is substantially the same as the scope of the claims examined in the Non-final Office Action dated 6/27/2007 and because each of the features of applicant's



claimed invention as amended continues to be anticipated by and unpatentable or obvious over the prior art.

***Response to Arguments***

Applicant's arguments filed in the Response dated 9/27/2007 with respect to Examiners' rejection under 35 U.S.C. § 102(e) have been considered fully and are unpersuasive in light of the evidence substantially disclosed in the Baerlocher '395 and Baerlocher '273 references, in view of applicant's amendments and in view of applicant's arguments thereof.

Applicant's arguments filed in the Response dated 9/27/2007 with respect to Examiners' rejection under 35 U.S.C. § 103(a) are moot in light of claims 7, 9 and 13 being drawn to a non-elected species.

Regarding applicant's arguments and amendments concerning claims 18-21 rejected as anticipated under 35 U.S.C. § 102(e):

Applicant argues substantially that Baerlocher '395 does not teach that one or more different jackpots are awarded based on the outcome of a jackpot-incrementing symbol being displayed in a column so as to increment the jackpot in that column by the amount displayed because applicant believes that Baerlocher '395 teaches a single jackpot that is incremented by a percentage of a players' bets. Examiner continues to submit with respect to claim 18 as described in the Non-final Office Action dated

6/27/2007 that Baerlocher '395 discloses that the primary game displays the plural symbols in at least one row and in multiple columns (Figs. 1A and 1B, 34, Baerlocher '395), that each jackpot is associated with a column or different single column (column 9, lines 28-47, Baerlocher '395; jackpots are displayed in reel columns upon spinning reels), and that a jackpot associated with a particular column is incremented when a jackpot-incrementing symbol is displayed in that column (column 10, lines 30-55, Baerlocher '395; the jackpot amount is incremented when a jackpot-incrementing symbol or "7" symbol occurs in an adjacent column three times) regardless of whether other features of claim 18 are substantially the same as features of claim 16 described in the Non-final Office Action dated 6/27/2007.

Applicant argues substantially that Baerlocher '395 does not teach that plural N or five different jackpots are awarded based on the outcome of a occurrence of certain icons being displayed in a primary game so as to increment the jackpot by the amount displayed because applicant believes that Baerlocher '395 teaches a single jackpot that is incremented by a percentage of a players' bets. Examiner continues to submit with respect to claim 21 as described in the Non-final Office Action dated 6/27/2007 that Baerlocher '395 discloses that one or more jackpots, which are a number of jackpots, are awarded (column 11, lines 27-67 and column 15, lines 16-37, Baerlocher '395; at least one jackpot is awarded), and the plurality of jackpots are incremented based on, at least in part, the occurrence of certain icons displayed in the primary game (column 18, lines 32-47, Baerlocher '395; plural awards or jackpots are increased or incremented

based on plural icons or shields in the game) regardless of whether other features of claim 21 are substantially the same as features of claim 16 described in the Non-final Office Action dated 6/27/2007.

Applicant amended claim 18 to recite "awarding at least one of the N jackpots to a player upon the player achieving a jackpot winning outcome." Examiner submits that Baerlocher discloses the aforementioned feature of claim 18 in claim 21 as described in the Non-final Office Action dated 6/27/2007 in that Baerlocher '395 discloses that one or more jackpots, which are a number of jackpots or at least one of the N or five jackpots, are awarded to the player (column 11, lines 27-67 and column 15, lines 16-37, Baerlocher '395; at least one jackpot is awarded)

Consequently, applicant's arguments have been deemed to be unpersuasive, in part, in light of the evidence substantially disclosed in the Baerlocher '395 reference, but also with respect to the Baerlocher '273 reference, in part, in light of applicant's amendments, and, in part, in light of applicant's arguments thereof. Hence, Examiner maintains the grounds of rejection of the claims under 35 U.S.C. § 102(e) as described in the Non-final Office Action dated 6/27/2007 because each of the features of applicant's claimed invention continues to be anticipated by the prior art.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A US-7,252,591 B2, Van Asdale.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur O. Hall whose telephone number is (571) 270-1814. The examiner can normally be reached on Mon - Fri, 8:00am - 5:00 pm, Alt Fri, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AH

11/19/2007



Xuan M. Thai  
Supervisory Patent Examiner